

REMARKS

Claims 9-16,18-30, 35-53, and 77-104 are under consideration.

The Office Action refers to *Response to Amendment*

1. The examiner acknowledges the amendments of claims 40-53, and 77-100.

Currently, claims 103-104 has been newly added, and claims 1-8,17, 31-34, and 54-76 are canceled. Thus, claims 9-16,18-30, 35-53, and 77-104 are pending.

Applicant appreciates the entry into the file of the newly added claims.

The Office Action refers to Election/Restrictions.

Please note: A restriction requirement is being made at this time due to the applicant's amendments and newly added claims, and examiner's understanding of the differences and distinctions of the claim language.

Applicant understands that the Examiner has the purpose of advancing prosecution of this application.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 9-16,18-26, 35-37, and 77-83, drawn to a method for operating a coin activated entertainment automat, classified in class 463, subclass 20.
 - II. Claims 27-30, 38-53, and 84-98, drawn to a system of entertainment automats, classified in class 463, subclass 42.

- III. Claims 99-104, drawn to a method for operating an entertainment automat system, classified in class 463, subclass 16.

The inventions are distinct, each from the other because of the following reasons:

3. Invention I and Inventions II are related as process and apparatus for its practice.

Applicant respectfully disagrees. There is no apparatus claim among claims 27 to 30, 38 to 53, and 84 to 98 of Invention II. Claims 27 to 30 relate to a system for operating a coin actuated entertainment automat with substantial method limitations. Claims 38 to 53 and 84 to 98 relate to a method of running a plurality of entertainment automats, which claims are clearly not directed to an apparatus. Therefore, Invention I and Inventions II cannot be related as process and apparatus for its practice, since Invention II is not directed to an apparatus.

The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the system of Invention II can be used to practice another and materially different process such as playing a network of entertainment automats.

Applicant respectfully disagrees. There is no other and materially different process which can be used with claims 38 to 53 and 84 to 98, since these claims are already method claims.

4. Inventions I and III are directed to related processes. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the

inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05Q). In the instant case, the inventions as claimed have a materially different design such that Invention III has a network of entertainment automats. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Claims 10, 13, 16, 22, and 25 are associated with Invention I, but they all have a network of entertainment automats. Thus these method claims of Invention I relate to a network of entertainment automats as do the claims 99 to 104 of Invention III. Thus the presence of a network of entertainment automats does not distinguish the Invention III claims from the Invention I claims 10, 13, 16, 22, and 25.

5. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of Invention III as claimed can be used practiced by another and materially different apparatus that has keys such as "hold key" and "Hand out key".

Applicant respectfully disagrees. There is no apparatus claim among claims 27 to 30, 38 to 53, and 84 to 98 of Invention II. Claims 27 to 30 relate to a system for operating a coin actuated entertainment automat with substantial method limitations. Claims 38 to 53 and 84 to 98 relate to a method of running a plurality of entertainment automats, which claims are

clearly not directed to an apparatus. Therefore, Invention III and Invention II cannot be related as process and apparatus for its practice, since Invention II is not directed to an apparatus.

6. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;

Applicant responds that the inventions set forth in the Office Action do not have acquired a separate status in the art and they are closely related. The differences in classification do not support that the various methods are necessarily different inventions.

- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

Applicant submits that no art has been provided in the Office Action, which art would cause a separation into three inventions due to divergent subject matter.

- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

Applicant urges that the claims pending are so related that the search material is essentially a common search material relating to all pending claims.

- (d) the prior art applicable to one invention would not likely be applicable to another invention;

There is the likelihood that prior art applicable to one invention would also be likely to be applicable to another invention. For example, material relating to Invention III in the way of a network of entertainment automats would also be relevant to claims 10, 13, 16, 22, and 25 of Invention I.

- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

The claims are presented in one application and no reason is given in the Office Action as to why the claims should raise different non-prior art issues along the lines of the proposed restriction requirement.

Applicant is advised that the reply to this requirement to be complete must include

- (i) an election of a invention to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

Applicant elects the Invention II to be prosecuted. Invention II according to the Office Action relates to claims 27 to 30, 38 to 53, and 84 to 98.

The election of an invention may be made with or without traverse.

The election of Invention II is made with traverse.

To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant believes that there is no prior art, which would render Invention I, Invention II, and Invention III to be separate inventions. Applicant believes that the Restriction Requirement issued in the Office Action is improper.

7. **After electing one of the above Inventions of I, II, or III, an further election of species is also required within the elected Invention.**

8. This application contains claims directed to the following patentably distinct species:

If Invention I is elected, applicant is further required to elect one of the following species of Invention I:

1A. Claims 9-10,18-26, 35-37, and 77-83

1B. Claims 11-14

If Invention II is elected, applicant is further required to elect one of the following species of Invention II:

2A. Claims 27-30

2B. Claims 38-53, 84-98

Applicant elects Invention II and the species 2B with claims 38 to 53, and 84 to 98.

If Invention III is elected, applicant is further required to elect one of the following species of Invention III:

3A. Claims 99-100, and 103

3B. Claims 101-102

3C. Claim 104

9. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant elects Invention II and the species 2B with claims 38 to 53, and 84 to 98.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Applicant elects Invention II and the species 2B with claims 38 to 53, and 84 to 98.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the


examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Reconsideration of all outstanding requirements is respectfully requested.

Entry of the present response is respectfully requested. All claims as submitted are deemed to be in form for allowance and an early notice of allowance is earnestly solicited.

Respectfully submitted,
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